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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,496

07/27/2006

Hajime Mackawa

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EXAMINER

BENZON, GREG C

ART UNIT

PAPER NUMBER

2444

NOTIFICATION DATE

DELIVERY MODE

01/26/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patdocket@pearne.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/597,496	<b>Applicant(s)</b> MAEKAWA ET AL.	
	<b>Examiner</b> GREG BENZON	<b>Art Unit</b> 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4,5,8-16,20,21,24-28,32,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-5, 8-16, 20-21, 24-28, 32, 36-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/27/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This application has been examined. Claims 4-5, 8-16, 20-21, 24-28, 32, 36-37 are pending. Claims 1-3, 6-7, 17-19, 22-23, 29-31, 33-35, 38-53 are cancelled.

### ***Priority***

This application claims benefits of priority from Foreign Application 2004-022902 filed January 30, 2004. (JAPAN)

The effective date of the claims described in this application is January 30, 2004.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 07/27/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-5, 8-16, 20-21, 24-28 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 4-5, 8-16, 20-21, 24-28 are directed towards '*device*' and '*a server*' and '*system*' comprised of '*tunnel communication part*', '*judgment part*' and '*address determination part*'. Upon inspection of the Applicant Specifications Pages 14,18,41,130 the Examiner concludes said *devices*, *server*, *system* and *parts* are nothing more than software components.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 8-10, 16, 20-21, 24-28 , 32, 36-37 rejected under 35 U.S.C. 103(a) as being unpatentable over Verma (US Patent 6614809 ) in view of what was well-known in the networking art.

Verma disclosed (re. Claim 4 ) an information- processing device for a communication source that performs tunnel communication with a communication destination device, comprising:

a tunnel communication part for performing the tunnel communication with encapsulated communication target data;(Verma-Column 4 Lines 15-45)

a judgment part for determining whether the information-processing device is a caller or a callee in the tunnel communication; (Verma-Column 8 Lines 30-45) and

an address determination part for determining an address used for the communication target data according to the determination by the judgment part.

(Verma-figure 7a,Column 4 Lines 35-55, Column 6 Lines 15-35)

While Verma does not explicitly disclose distinguishing between a caller or callee it would have been obvious to a person of ordinary skill in the networking art that a remote client that originates the tunnel request is a caller, and the responding entity on

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the second network is a callee and that Verma is able to distinguish between the caller and callee.

Claims 16, 28 (re. system) is rejected on the same basis as Claim 4.

Claims 20 (re. server) is rejected on the same basis as Claim 4.

Claims 32 (re. method) is rejected on the same basis as Claim 4.

Verma disclosed (re. Claim 5,21 ) wherein the address determination part determines the address used for the communication target data by selecting from a plurality of predetermined addresses. (Verma- Column 6 Lines 35-55)

Verma disclosed (re. Claim 8,24 ,36,37) a tunnel communication identifier acceptor for accepting a tunnel communication identifier for identifying the tunnel communication; wherein the address determination part determines an address used for the communication target data, according to the determination by the judgment part and the tunnel communication identifier. (Verma-Column 7 Lines 35-55)

Verma disclosed (re. Claim 9,25 ) wherein the address determination part determines a part of the address used for the communication target data according to the tunnel communication identifier, and determines another part of the address used for the communication target data according to the determination by the judgment part. (Verma-Column 6 Lines 35 thru Column 7 Lines 55)

Verma disclosed (re. Claim 10,26 ) wherein the address determination part determines at least a part of the address used for the communication target data by selecting from a plurality of predetermined addresses. (Verma-Column 6 Lines 35 thru Column 7 Lines 55)

Verma disclosed (re. Claim 27 ) wherein the address output part transmits the first address and the second address to the first information-processing device and the second information-processing device. (Verma-Column 6 Lines 35 thru Column 7 Lines 55)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Verma (US Patent 6614809 ) in view of Keane (US Patent 7395354).

While Verma substantially disclosed the claimed invention Verma did not disclose (re. Claim 11 ) a detection part for detecting whether two or more addresses used for the communication target data are the same in the two or more tunnel communications; and an address changing part for changing at least one of the addresses used for the communication target data if the detection part detects that two or more addresses are the same.



Keane disclosed (re. Claim 11 ) a detection part for detecting whether two or more addresses used for the communication target data are the same in the two or more tunnel communications; (Keane-Column 8 Lines 25 thru Column 9 Lines 25) and an address changing part for changing at least one of the addresses used for the communication target data if the detection part detects that two or more addresses are the same. (Keane-Column 8 Lines 25 thru Column 9 Lines 25)

Verma and Keane are analogous art because they present concepts and practices regarding establishment of tunnels and tunnel identifiers. At the time of the invention it would have been obvious to combine Keane into Verma. The motivation for said combination would have been to enable a less cumbersome approach for resolving address conflicts in networks. (Keane-Column 2 Lines 15-25)

Verma-Keane disclosed (re. Claim 12) an address change information receiver for receiving address change information including information related to an address change; (Keane-Column 8 Lines 25 thru Column 9 Lines 25) and an address changing part for changing the address used for the communication target data, according to the address change information. (Keane-Column 8 Lines 25 thru Column 9 Lines 25)

Verma-Keane disclosed (re. Claim 13 ) a detection part for detecting whether two or more addresses that are used for the communication target data are the same in the two or more tunnel communications; (Keane-Column 8 Lines 25 thru Column 9 Lines

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25)

an address agreement information transmitter for transmitting address agreement information showing that addresses are the same if the detection part detects that two or more addresses are the same; (Keane-Column 8 Lines 25 thru Column 9 Lines 25)

an address change information receiver for receiving address change information including information related to address change; (Keane-Column 8 Lines 25 thru Column 9 Lines 25) and

an address changing part for changing the address used for the communication target data according to the address change information. (Keane-Column 8 Lines 25 thru Column 9 Lines 25)

Verma-Keane disclosed (re. Claim Claim 14 ) an address output part for outputting the address determined by the address determination part. (Keane-Column 8 Lines 25 thru Column 9 Lines 25)

Verma-Keane disclosed (re. Claim 15) wherein the address output part transmits the address determined by the address determination part. (Keane-Column 8 Lines 25 thru Column 9 Lines 25)

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREG BENGZON whose telephone number is (571)272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Bengzon/  
Examiner, Art Unit 2444